

**REMARKS/ARGUMENTS**

The following remarks address the objections and rejections contained in the Office Action mailed June 3, 2004.

**Drawings**

Paragraph 2 of the Action noted that the Draftsperson has objected to the drawings. Applicant has submitted new drawings with this response that the Applicant believes address the Draftsperson's Objections.

**Claim Objections**

Paragraph 7 of the Action objects to an informality found in line 2 of claim 24, i.e. that "configure" in line 2 of claim 24 should be --configured--. Applicant has amended claim 24 to correct the misspelling. Accordingly, Applicant believes that the claim objections have been addressed.

**Claim Rejections under §103**

Paragraph 8 of the Action rejects claims 17-19 under 35 U.S.C. §103(a) as being unpatentable over Garin (U.S. Patent 6,427,120). With respect to independent claim 17, Applicant respectfully traverses the rejection for at least the reasons indicated below. In order for claim 17 to be rendered obvious by Garin, Garin must teach or suggest all the limitations of claim 17. As stated in Paragraph 8 of the Action, Garin fails to teach the disabling of the wireless receiver once assistance data has been determined to not be present. Because this is a limitation of claim 17, Garin does not teach each and every element of claim 17. Therefore, Garin must include some suggestion or motivation to modify the teaching of Garin, as well as a

**Amendments to the Drawings:**

The attached sheet of drawings includes changes to Figures 1-4 and 11. Applicant believes that the numbers, letters, and reference characters in each of these figures complies with the height requirement of 37 C.F.R. 1.84(p)(3).

Attachments: Replacement Sheets

Annotated Sheet Showing Changes

reasonable expectation that any such modifications will be successful. The teaching or suggestion to make the modification to the teachings of Garin and the reasonable expectation of success must both be found in Garin and cannot be based on Applicant's disclosure. (see MPEP § 706.02(j)).

Claim 17 teaches a specific method for switching between operational modes in response to a received position request. Specifically, when the position request is received, the wireless communication device will first attempt to act in a network assisted mode by ascertaining the availability of network assist information. If no network assist information is available, then the wireless communication device will switch to GPS standalone mode. The switch to GPS standalone mode is specifically achieved by deactivating a wireless communication transceiver, activating a GPS receiver, and then receiving GPS signals via the GPS receiver. While Garin does teach several specific methods by which the device can employ the multimode architecture taught therein by taking advantage of network assistance if available or acting independently if not available (see col. 9, lines 4-9), Garin does not teach the limitation of deactivating a wireless communication receiver when network assisted positioning is not available.

Although this limitation is not found in Garin, the Action argues that it is “well known in the art” to disable components of a wireless device that are not in use, and that “one of ordinary skill in the art” would recognize from Garin’s teachings to disable the wireless receiver when network assistance is unavailable. However, each finding of fact on which a conclusion of obviousness is based must be supported by substantial evidence and, in particular, the conclusion that the prior art suggests or motivates the modification of a prior art reference must be based on findings supported by substantial evidence. In re Kotzab, 217 F.3d 1365, 1370-71 (Fed. Cir. 2000). Hence, a *prima facie* case of obviousness cannot be made out by merely asserting that

modifications to the prior art are “well within the ordinary skill of the art.” Ex Parte Leavengood, 28 USPQ2d 1300 (Bd. Pat. App. & Intent 1993). While Garin generally suggests disabling components to reduce power consumption in the GPS device (see col. 10, lines 21-23), Garin does not provide a suggestion or motivation for a method that automatically disables the wireless communication receiver when network assisted positioning is not available.

The Action attempts to provide this motivation, and the requisite likelihood of success, by stating that it is so obvious Garin didn’t think to put it into words. Such an analysis completely fails to meet the substantial evidence requirement for a *prima facie* case of obviousness, because the fact that Garin, and the entirety of the extensive prior art cited to date, does not put into words the specific method claimed in independent claim 17 is clearly evidence of its non-obviousness. Applicant finds no support in patent law for the proposition that the fact that none of the references cited disclose disabling the wireless receiver when network assistance is unavailable is grounds for a finding of obviousness as put forth in the Action. Rather, Applicant believe that the law is quite settled in favor of a finding of non-obviousness in this case.

Accordingly, Applicant respectfully submits that the section 103 rejection of claim 17 and claims 18-19 dependent therefrom should be withdrawn.

Paragraph 9 of the Action rejects claims 17-19 under 35 U.S.C. §103(a) as being unpatentable over Garin in view of Syrjarinne (U.S. Patent Pub. US 2003/0107514). Applicant respectfully traverses the rejection for at least the reasons indicated below. The Action states that based on Garin’s disclosure of power savings, one of ordinary skill in the art would look to other known power savings means/methods, and would be led to Syrjarinne’s general teaching of disabling components of a mobile wireless device that are not in use. However, Syrjarinne’s

general teachings with respect to power savings (paragraph 13-14) do not add anything beyond Garin. The general comments of Syjarinne cited in the Action are already taught by Garin, i.e., "...the present invention...allows parts of the GPS receiver system to be selectively powered to reduce power consumption of the GPS portion of the mobile device" (see Garin, col. 8, lines 19-23). As a result, Syjarinne does not provide one of ordinary skill in the art with any additional suggestion or motivation, beyond the teachings of Garin itself, to modify Garin to provide a method for obtaining position information using a communication network that comprises disabling the wireless communication receiver when network assisted positioning is not available. Accordingly, Applicant respectfully submits that the section 103 rejection of claim 17 and claims 18-19 dependent therefrom should be withdrawn.

Paragraph 10 of the Action rejects claims 1, 3-4, 28, and 41-45 under 35 U.S.C. §103(a) as being unpatentable over Garin in view of Kasner '363 and Breems. Claims 1, 3-4, 41-43, and 45 have been amended such that they ultimately depend from claim 44, which Applicant believes is allowable over the art of record for at least the reasons stated below. Applicant, therefore, respectfully requests that the rejection be withdrawn as to claims 1, 3-4, 41-43, and 45 as they are dependent on claim 44, which is allowable over the art of record.

Claim 44 teaches a specific method for switching between operational modes in response to a received position request. Specifically, claim 44 is directed to the method of claim 17. Accordingly, Applicant asserts that claim 44 is allowable for at least the reasons stated above with regard to claim 17. Accordingly, Applicant respectfully request that the rejection be withdrawn as to claim 44.

Paragraph 11 of the Action rejects claims 20-21, 24, 27, and 29 under 35 U.S.C. §103(a) as being unpatentable over Garin, Kasner '363, and Breems as applied to claims 4 or 41 in view

further of Leisten. Applicant respectfully traverses the rejection because each of claims 20-21, 24, 27, and 29 ultimately depend from claim 44, which is allowable over the art of record for at least the reasons stated above. Accordingly, Applicant respectfully requests withdrawal of the rejection as to claims 20-21, 24, 27, and 29.

Paragraph 12 of the Action rejects claims 22 and 26 under 35 U.S.C. §103(a) as being unpatentable over Garin, Kasner '363, Breems, Leisten, and as applied to claims 4 or 20 in view further of Bork. Applicant respectfully traverses the rejection because each of claims 22 and 26 ultimately depend from claim 44, which is allowable over the art of record for at least the reasons stated above. Accordingly, Applicant respectfully requests withdrawal of the rejection as to claims 22 and 26.

Paragraph 13 of the Action rejects claims 22 and 26 under 35 U.S.C. §103(a) as being unpatentable over Garin, Kasner '363, Breems, Leisten, and as applied to claims 4 or 20 in view further of Haartsen. Applicant respectfully traverses the rejection because each of claims 22 and 26 ultimately depend from claim 44, which is allowable over the art of record for at least the reasons stated above. Accordingly, Applicant respectfully requests withdrawal of the rejection as to claims 22 and 26.

Paragraph 14 of the Action rejects claims 20 and 21 under 35 U.S.C. §103(a) as being unpatentable over Garin, Kasner '363, Breems, as applied to claims 4 and 12, and further in view of Standke. Applicant respectfully traverses the rejection because each of claims 20 and 21 ultimately depend from claim 44, which is allowable over the art of record for at least the reasons stated above. Accordingly, Applicant respectfully requests withdrawal of the rejection as to claims 20 and 21.

Paragraph 15 of the Action rejects claims 22-23, 26, and 46-47 under 35 U.S.C. §103(a) as being unpatentable over Garin, Kasner '363, Breems, and Standke as applied to claims 4 and 20, and further in view of Bork. Applicant respectfully traverses the rejection because each of claims 22-23, 26, and 46-47 ultimately depend from claim 44, which is allowable over the art of record for at least the reasons stated above. Accordingly, Applicant respectfully requests withdrawal of the rejection as to claims 22-23, 26, and 46-47.

Paragraph 16 of the Action rejects claims 22-23, 26, and 46-47 under 35 U.S.C. §103(a) as being unpatentable over Garin, Kasner '363, Breems, and Standke as applied to claims 4 and 20, and further in view of Haartsen. Applicant respectfully traverses the rejection because each of claims 22-23, 26, and 46-47 ultimately depend from claim 44, which is allowable over the art of record for at least the reasons stated above. Accordingly, Applicant respectfully requests withdrawal of the rejection as to claims 22-23, 26, and 46-47.

#### **Miscellaneous Claim Amendments**

Due to the claim amendments described above, several miscellaneous claim amendments were required to maintain consistency between the claims as well as between the claim language and terms. In making these miscellaneous claim amendments, Applicant believes that no new matter was added.

**CONCLUSION**

Upon entry of this amendment, claims 1, 3, 4, 17, 18, 19, 20 – 24, 26-29, and new claims 41-47 are pending. Claims 2, 5-16, 25, and 30-40 have been cancelled. Based on the above amendments and remarks, Applicants believe that the claims are in condition for allowance and such is respectfully requested. Applicants assert that no new matter has been introduced as a result of these amendments.

The Commissioner is hereby authorized to charge any fees required by this response to our Deposit Account No. **50-2613** (Order No. 37945.00012.UTL1).

Respectfully Submitted,

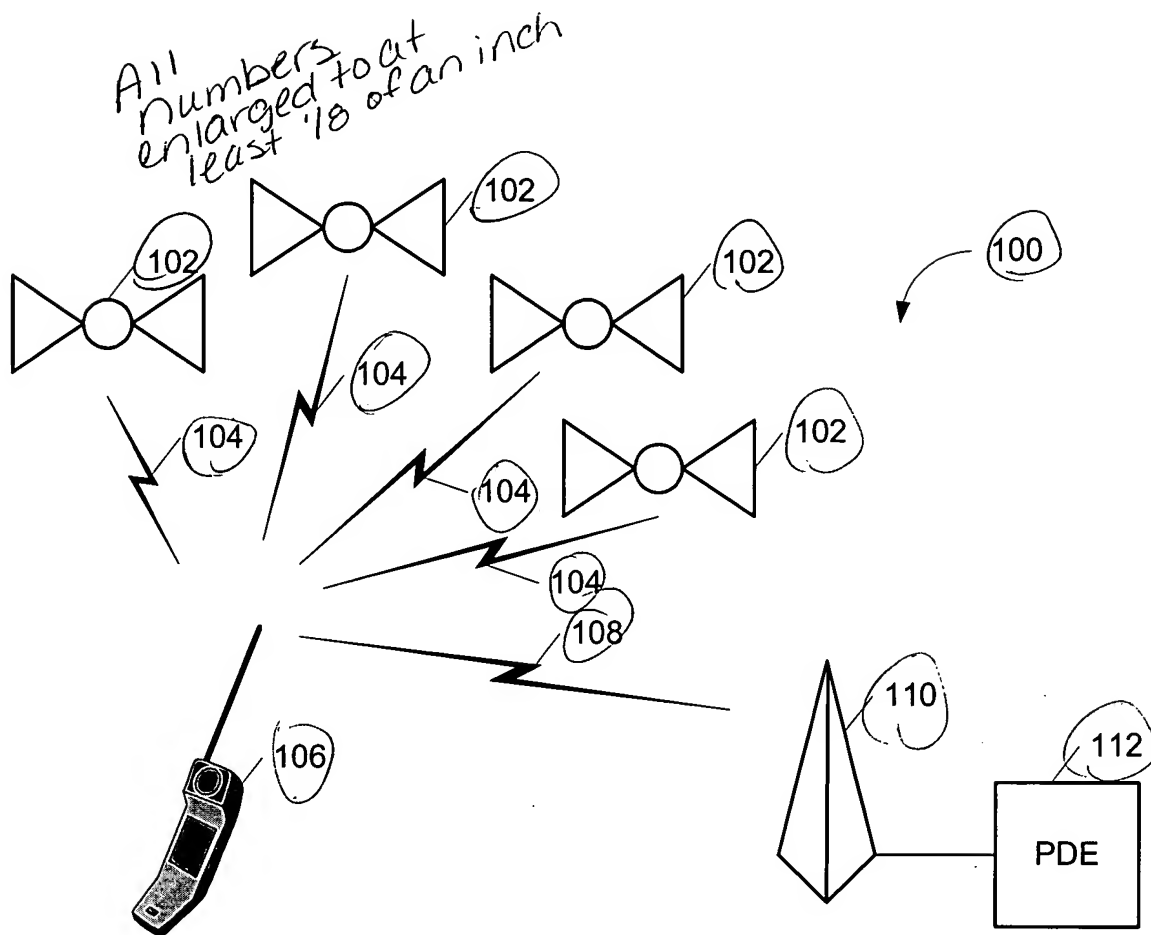
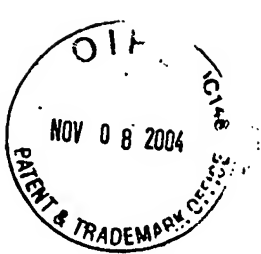
Dated: November 3, 2004

By: 

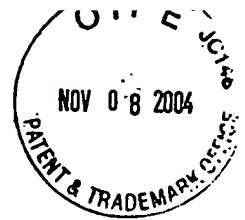
Noel C. Gillespie  
Reg. No. 47,596

PAUL, HASTINGS, JANOFISKY & WALKER  
Customer No. 36183  
P.O. Box 92191  
San Diego, CA 92191-9092  
PH: (858) 720-2500  
FX: (858) 720-2555

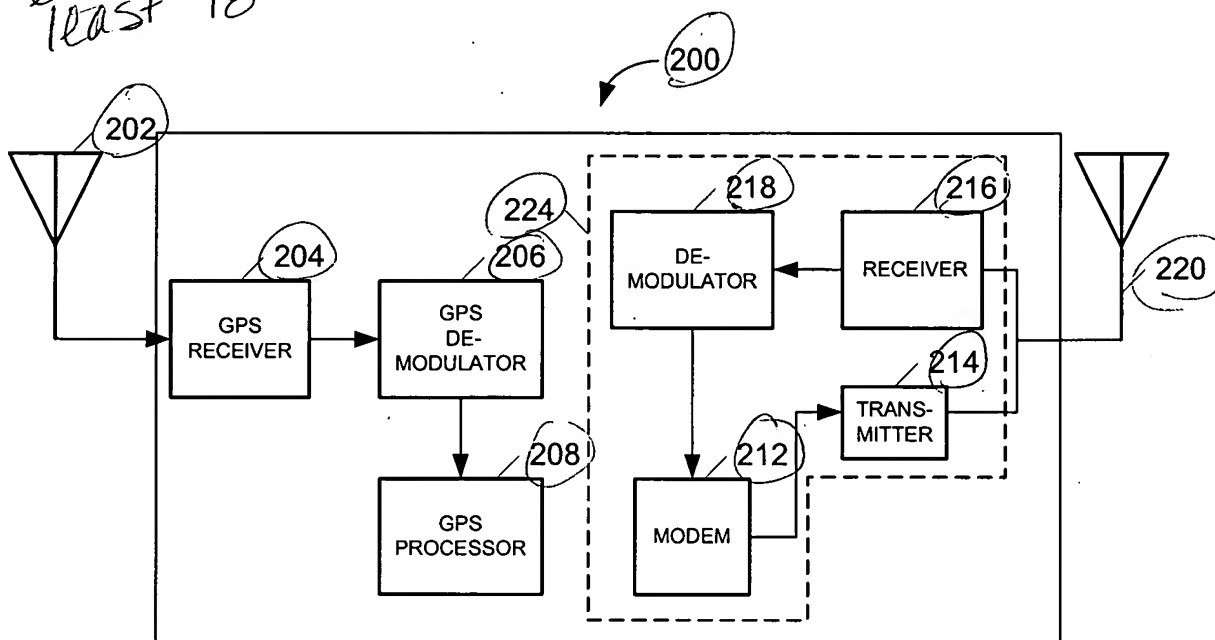




**Figure 1**



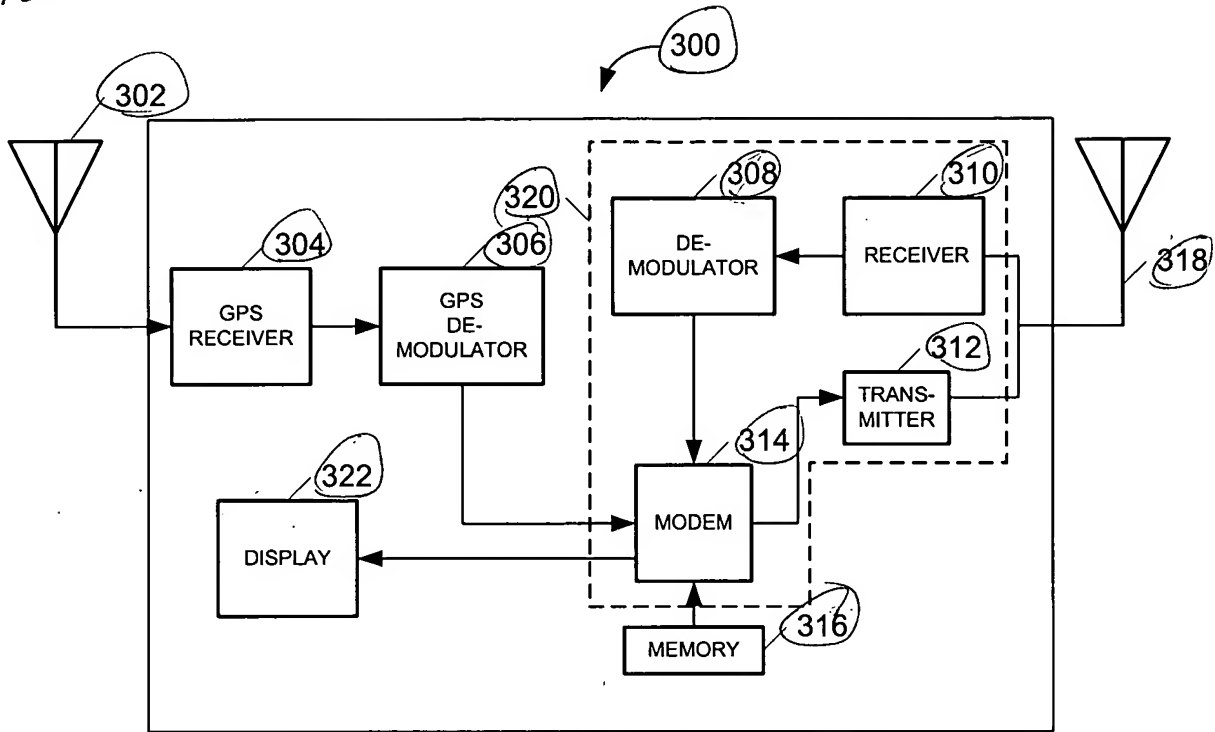
All numbers  
enlarged to at  
least 1/8 of an inch



**Figure 2**



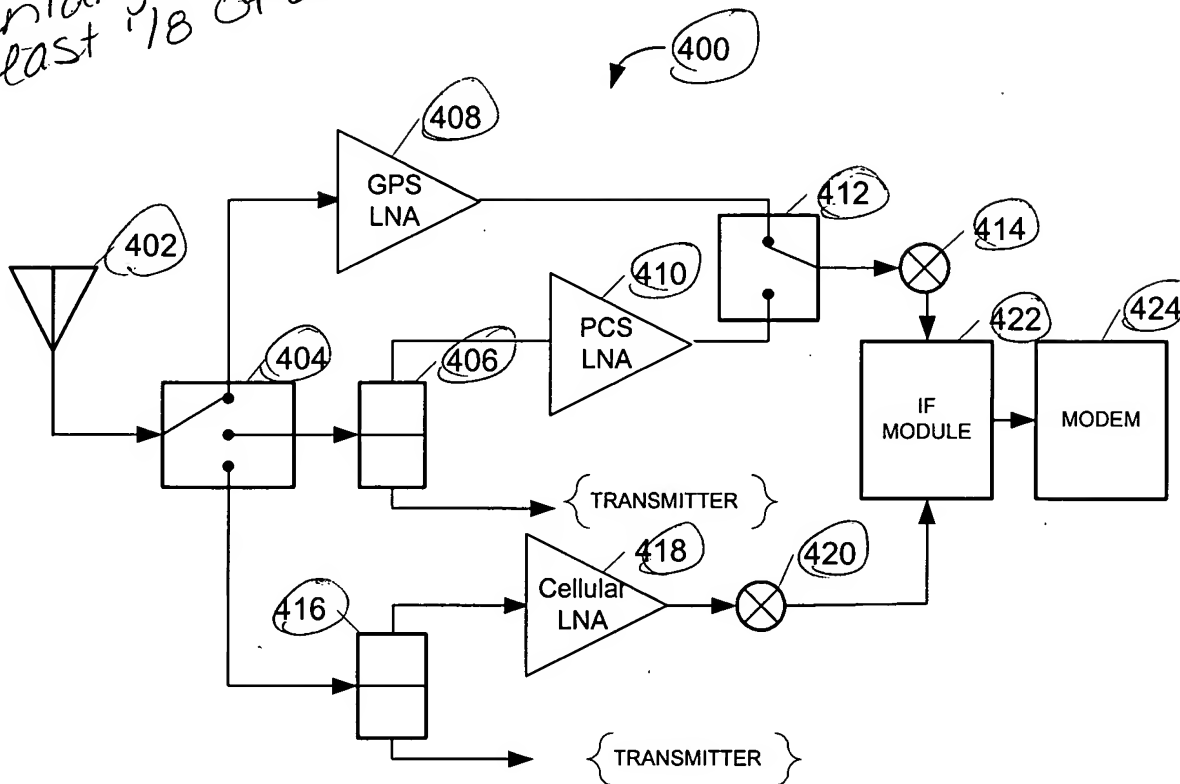
All numbers  
enlarged to at  
least 1/8 of an inch



**Figure 3**



All numbers  
enlarged to at  
least 1/8 of an inch

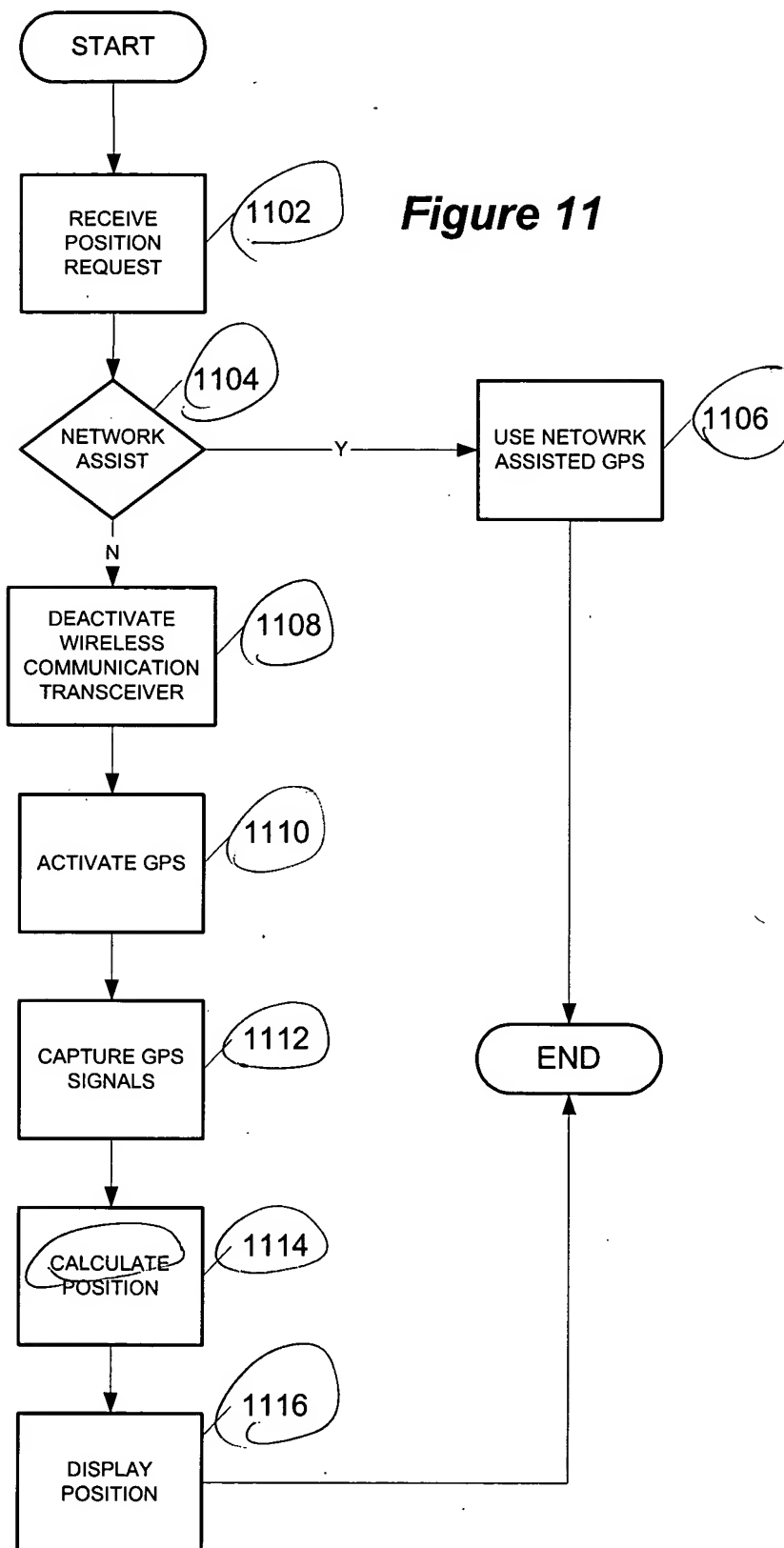


**Figure 4**



All numbers  
enlarged to at  
least 1/8 of an  
inch

**Figure 11**



calculate  
changed to  
calculate